

**Notice of Allowability**

Application No.

10/669,559

Examiner

Janis L. Dote

Applicant(s)

KAMEYAMA ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/27/04.
2. ☒ The allowed claim(s) is/are 1,5 and 7-18.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 12/19/03;10/25/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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1. The examiner acknowledges the cancellation of claims 2-4 and 6, the amendments to claims 1, 8, 10, and 11, and the addition of claims 12-18 set forth in the amendment filed on Dec. 27, 2004.

2. The examiner has considered only the material submitted by applicants, i.e., copies of the originally filed claims and the abstract of US application Serial. No. 10/373,729, which is listed in the "List of related cases" in the Information Disclosure Statement (IDS) filed on Oct. 25, 2004.

The examiner has crossed-out the form PTO-1449 in the IDS filed on Oct. 25, 2004, because the references listed on the form PTO-1449 have been already considered. See the examiner-initialed form PTO-1449 filed on Dec. 19, 2003, attached to the office action mailed on Sep. 27, 2004.

#### EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

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Authorization for this examiner's amendment was given in a telephone interview with Mr. Donald Drummond (Reg. No. 52,834) on Mar. 2, 2005.

The specification has been amended as follows:

In the amended paragraph filed on Dec. 27, 2004, beginning at page 3, line 9, of the specification, at lines 2 and 3, in each occurrence delete the term "Aerosil" and insert the term -- AEROSIL --.

In the amended paragraph filed on Dec. 27, 2004, beginning at page 24, line 11, of the specification, at lines 2 and 3, in each occurrence delete the term "Aerosil" and insert the term -- AEROSIL --.

At page 24, line 4, delete the term "Viscol" and insert the term -- VISCOL --.

At page 25, lines 19 and 21, at page 26, line 25, and at page 27, line 2, in each occurrence delete the term "Aerosil" and insert the term -- AEROSIL --.

Claims 10 and 17 have been amended as follows:

In claim 10, at line 2, delete the phrase "applying a toner to" and insert the phrase -- fixing a toner image carried on a sheet to the sheet with --,

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At lines 3-4, after the phrase "heat energy to the toner" delete the phrase "in the non-contact fixing apparatus" and insert the phrase -- image on the sheet in a non-contacting state --, and

At line 4, delete the term "comprises" and insert the phrase -- image is formed by a toner comprising --.

In claim 17, at line 2, delete the phrase "applying a toner to" and insert the phrase -- fixing a toner image carried on a sheet to the sheet with --,

At line 3, after the phrase "heat energy to the toner" delete the phrase "in the non-contact fixing apparatus" and insert the phrase -- image on the sheet in a non-contacting state --, and

At line 4, delete the term "comprises" and insert the phrase -- image is formed by a toner comprising --.

The examiner notes that the originally filed specification provides antecedent basis at page 12, lines 19-25, for the examiner's amendment to claims 10 and 17.

4. The examiner's amendment to the specification set forth in paragraph 3 above overcomes the objection to the specification set forth in the office action mailed on Sep. 27, 2004, paragraph 2.

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The examiner's amendment to claim 10 overcomes and the amendment to claim 17 avoids the rejection under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Sep. 27, 2004, paragraph 6, regarding claim 10.

#### REASONS FOR ALLOWANCE

5. The following is an examiner's statement of reasons for allowance:

The objection to the specification set forth in the office action mailed on Sep. 27, 2004, paragraph 2, has been withdrawn in response to the amended paragraphs filed on Dec. 27, 2004, to the specification, and to the examiner's amendment to the specification set forth in paragraph 3, supra.

The rejections of claims 2-4, 6, 8, 10, and 11 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Sep. 27, 2004, paragraph 6, have been withdrawn in response to cancellation of claims 2-4 and 6, and the amendments filed on Dec. 27, 2004 to claims 8, 10, and 11, and the examiner's amendment to claim 10 set forth in paragraph 3, supra.

The rejections of claims 2-4, 10, and 11 under 35 U.S.C. 101, set forth in the office action mailed on Sep. 27, 2004,

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paragraph 8, have been withdrawn in response to cancellation of claims 2-4 and the amendments filed on Dec. 27, 2004 to claims 10 and 11.

The rejections under 35 U.S.C. 103(a) of claims 1-5 and 8 over US 5,707,771 (Matsunaga) combined with US 6,156,471 (Kobori), of claims 1-5 and 7 over Matsunaga combined with US 6,248,495 B1 (Inokuchi), and of claim 9 over Matsunaga combined with either Kobori or Inokuchi and the other cited prior art, set forth in the office action mailed on Sep. 27, 2004, paragraphs 12-15, respectively, have been withdrawn in response to the amendment filed on Dec. 27, 2004, to claim 1, adding the limitation that the ratio ( $G'_{60}/G'_{70}$ ) of the storage modulus at 60°C ( $G'_{60}$ ) to the storage modulus at 70°C ( $G'_{70}$ ) be "2 or more and less than 30." As noted by applicants in their response filed on Dec. 27, 2004, page 10, lines 3-5 and 13-15, Matsunaga requires that the ratio  $G'_{60}/G'_{70}$  of the toner storage modulus at 60°C ( $G'_{60}$ ) to the toner storage modulus at 70°C ( $G'_{70}$ ) be "at least 30." Matsunaga, col. 4, lines 38, and col. 5, line 8. The ratio of "at least 30" is outside the range of "2 or more and less than 30" recited in instant claims 1 and 10. Matsunaga also teaches the disadvantages when the ratio  $G'_{60}/G'_{70}$  is below 30. Col. 5, lines 9-12. Accordingly, Matsunaga does not teach or suggest a toner as recited in instant claims 1

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and 10. The other cited prior art do not make up for the deficiencies in Matsunaga.

Accordingly, claims 1, 5, and 7-11 are allowable over the prior art of record for the reasons discussed above.

Claims 12-18 are allowable for the reasons discussed in the office action mailed on Sep. 27, 2004, paragraph 16. Claim 12 includes the limitations of cancelled originally filed claim 6 and its base claim originally filed claim 1.

As discussed in paragraph 16, Matsunaga does not teach or suggest a toner comprising a substance having a number-average molecular weight as now recited instant claims 12 and 17. Nor is there enough evidence on the present record to reasonably presume that the toner rendered obvious over the teachings of Matsunaga comprises said substance in an amount of "1 to 4% by area" as recited in instant claims 12 and 17.

Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Mar. 2, 2005

  
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